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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,560	12/11/2003	Yukio Heki	AA554C	8765

27752 7590 01/26/2007
THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
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CINCINNATI, OH 45224

EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/733,560

Applicant(s)

HEKI ET AL.

Examiner

Igor N. Borissov

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/06/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 11/06/06 is acknowledged and entered. Claims 3 and 11-16 have been withdrawn. Claims 1 and 4 have been amended. Claims 1, 2 and 4-10 are currently pending in the application.

Claim Rejections - 35 USC § 112

Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2 and 4-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 2, 4-10 recite a series of steps which do not include a pre- or post-computer activity but merely perform a series of steps of receiving data and selecting an article, which can be understood as steps performed by a computer. A process is statutory if it requires physical acts to be performed outside of the computer, independent of, and following the steps performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure (*Diamond v. Diehr*, 450 U.S. at 187,209 USPQ at 8). The claims merely manipulate an abstract idea (receiving or generating data) without limitation to any practical application. A process which merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some inherent usefulness (*Sakar*, 558 F.2d at 1335,200 USPQ at 139).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Hisanaka et al. (US 2002/0096182) in view of Teagarden et al. (US 6,014,631).

Claim 1. Hisanaka et al. (Hisanaka) teaches a method of selection absorbent article based on information received about incontinence person, wherein said information is provided by a care person, and wherein said selecting of the absorbent articles such as disposable diapers and sanitary napkins is conducted to conform to the user's physiological and psychological requirements [0007]; [0011].

Hisanaka does not specifically teach that said received information includes information about incontinence devices which are currently used by the person.

Teagarden et al. (Teagarden) teaches a method of recommending a medication product to be used by a person for improving health condition of the person, wherein a new medication product is prescribed to a person based, at least in part, on information regarding medication product currently used by the person (C. 8, L. 42-50; C. 10, L. 60-63).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hisanaka to include that said received information includes information about product currently used by the person, as disclosed in Teagarden, because it would advantageously allow to design appropriate patient care through collection of appropriate information on a patient's use of medical products, and patient's satisfaction, as indicated in Teagarden (C. 6, L. 50-53).

Art Unit: 3628

Claims 2 and 10. The method steps disclosed in Hisanaka and Teagarden would be performed regardless how many articles are selected, and what type of articles is selected. The motivation to modify references would be to expand line of medical product offered to customers for accommodating various medical conditions of patients.

Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisanaka et al. in view of Teagarden et al. and further in view of Snitkin (US 2003/0046111).

Claim 4. Hisanaka in view of Teagarden teach all the limitations of claim 4, except specifically teaching that said step of receiving information comprises the step of indicating a question and a plurality of possible answers for selection.

Snitkin teaches a method for treating pelvic floor disorders, wherein in order to evaluate and improve the quality of health care, a plurality of questions with a plurality of possible answers for selection for each questions are provided to obtain information regarding urinary incontinence (Fig. 3d).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hisanaka in view of Teagarden to include that said step of receiving information comprises the step of indicating a question and a plurality of possible answers for selection, as disclosed in Snitkin, because it would dvantageously allow to improve the quality of health care, as specifically stated in Snitkin [0013].

Claims 5-9, see reasoning applied to claim 4. Information as to the specific content of the questions cannot change the method steps performed as disclosed in Hisanaka in view of Teagarden and further in view of Snitkin. Therefore, said information is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

MPEP 2106 (11) (C) states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation." The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed.

Response to Arguments

Applicant's arguments filed 11/06/06 have been fully considered but they are not persuasive.

In response to the applicant's argument that claims recite pre-computer activity, it is noted, that claims as currently recited, do not provide any indication that a computer is used in the claims. While claims recite a series of steps, which may be understood as steps performed by a computer, said steps comprise merely manipulation of data without progressing technological arts. A process is statutory if it requires physical acts to be performed outside of the computer, independent of, and following the steps performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure (*Diamond v. Diehr*, 450 U.S. at 187,209 USPQ at 8). The claims merely manipulate an abstract idea (receiving or generating data) without limitation to any practical application. A process which merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some inherent usefulness (*Sakar*, 558 F.2d at 1335,200 USPQ at 139).

In response to the applicant's argument that Hisanaka fails to disclose that said article is selected based on information received about articles currently used by the person, it is noted that Teagarden was applied for this feature. Specifically, Teagarden discloses a method of recommending a medication product to be used by a person for improving health condition of the person, wherein a new medication product is

Art Unit: 3628

prescribed/recommended to a person based, at least in part, on information regarding medication product currently used by the person (C. 8, L. 42-50; C. 10, L. 60-63).

In response to the applicant's argument that Teagarden does not teach that said product is an absorbent product, it is noted that Hisanaka teaches this feature. To this end the examiner points out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to recommending health-related products to a person based on person's characteristics of experience. The motivation to combine said references would be to advantageously allow to design appropriate patient care through collection of appropriate information on a patient's use of medical products, and patient's satisfaction, as indicated in Teagarden (C. 6, L. 50-53).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3628

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB

01/21/2007



IGOR N. BORISSOV
PRIMARY EXAMINER